

REMARKS

This Response seeks to place this reissue application in condition for allowance. In the Office Action mailed May 23, 2003 (hereinafter, the "OFFICE ACTION"), claim 3 was objected to because of a minor informality. Applicants have amended the 9th line of claim 3 to address the Examiner's concern. No other amendments to the claims have been made. No new matter has been added. A complete set of pending claims are included herein.

Further, the drawings filed April 26, 2000 were objected to based on incompliance with 37 C.F.R. §1.173(a)(2) and the previously indicated allowability of claims 12-41 has been withdrawn in view of a new restriction requirement under 35 U.S.C. §121. In addition, the OFFICE ACTION states that the reissue oath/declaration filed with this application is defective. These rejections are addressed below.

In the OFFICE ACTION, the Examiner requests a copy of the PTO-1449 form filed August 6, 2001. It should be noted that on May 22, 2003, Applicants submitted a copy of the PTO-1449 filed August 6, 2001, via facsimile, in response to a request made from the examiner via telephone. With that facsimile, Applicants also included a copy of the stamped "received" postcard, pertaining to the PTO-1449 submittal.

Objections to the Drawings

In the OFFICE ACTION, the drawings were objected to for not being compliant with 37 C.F.R. §1.173(a)(2). As clarification, Applicants respectfully submit that temporary drawings were

filed in compliance with 37 C.F.R. §1.174¹, which this reissue application is subject to². Accordingly, clean copies of the drawings were not required at the time of filing of this reissue application. However, to expedite prosecution of this reissue application, attached hereto is a clean copy of the drawings. No new matter has been added.

The Declaration, as Submitted, is Not Defective

In the OFFICE ACTION, the Examiner states that the reissue oath/declaration filed with this application is defective because "it fails to identify at least one error". Applicants respectfully submit that the Declaration for Reissue Under 37 C.F.R. §1.175 filed on April 26, 2000 (hereinafter, the "DECLARATION") clearly includes an acceptable statement of error that identifies at least one error. In more detail, the OFFICE ACTION states:

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. While the Declaration states that "...because we claimed less than we had a right to claim in the patent" and goes on to state that "we believe that it was error **not to include claims** directed to a method of operation within the memory device and this error unduly narrow the coverage of the original patent." However, this general statement is not an acceptable statement of an error.

The MPEP § 1414 (II) clearly require that a reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error cause the original patent to be defective. The oath/declaration must specifically identify an

¹ It should be noted that this reissue application was filed on April 26, 2000 and thus, is subject to the old rule governing drawing requirements per 37 C.F.R. §1.174, which was subsequently removed and reserved in later revisions of Title 37 C.F.R. and superceded by 37 CFR §1.173(a)(2).

² It should be noted that the drawing requirements pertaining to reissue applications as outlined in 37 C.F.R. §1.173(a)(2) do not apply to this application, but to reissue applications filed on or after November 7, 2000.

error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

It is respectfully submitted that in the DECLARATION, in identifying the error, applicants have clearly specified the phrase “transmitting memory requests to the memory device”³, which appears in independent claim 3 of the original patent (see col. 8, line 30-32 of the original patent). MPEP §1414 (II) states “In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.” (Emphasis added)

In more detail, Applicant’s DECLARATION states that “it was error not to include claims directed towards a method of operation within the memory device itself”, since it is believed that the claims in the original patent to be primarily directed towards “apparatus external to the memory device” and that “this error has unduly narrowed the coverage of the original patent.” In identifying this error, by way of example, applicants have clearly identified the phrase “transmitting memory requests to the memory device” which appears in claim 3 of the original patent.⁴

3 See page 2, line 2-3 of the DECLARATION.

4 Although it is not required to identify more than one word, phrase, or expression in an original claim, Applicants DECLARATION, in identifying the error, also identifies “a computer system”, which appears in independent claim 4 of the original patent. Indeed, “a computer system” and “transmitting memory requests to the memory device” are examples of “apparatus external to the memory device” and/or functionality of such “apparatus [that is] external to the memory device”.

Restriction is not Proper

In the OFFICE ACTION, the pending claims in this reissue application were subjected to a restriction requirement. Applicants direct the Examiners attention to 37 CFR §1.176 (July 1, 1999 edition) and M.P.E.P. §1450 (7th edition).

Applicants respectfully submit that the above-referenced reissue application was filed before the effective date of the pertinent rule change that permits restriction in a reissue application. The above-referenced reissue application was filed on April 26, 2000 and the changes to 37 CFR §1.176 permitting restriction in a reissue application became effective on November 7, 2000 (See, 37 CFR §1.176, Dec. 18, 2000 edition and 65 FR 54644 Sept 8, 2000⁵). Applicants respectfully submit that a restriction requirement in the instant application is not proper. Applicants respectfully request withdrawal of the restriction requirement.

⁵ 65 FR 54644 Sept 8, 2000 states that "Elimination of the prohibition against restriction in divisional application under §1.176 is effective for reissue applications filed on or after the date that is sixty days after the date of publication in the **Federal Register**."

CONCLUSION

Applicants request reconsideration of this reissue application in view of the foregoing remarks. Accordingly, withdrawal of the restriction requirement and allowance of all of the claims is respectfully requested.

Respectfully submitted,



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